

**REMARKS**

**Status of the Application**

Claims 1 and 3-13 are all the claims that have been examined in the application. Claims 1, 3-6 and 10-12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Small in view of Wang, both of which are previously of record. Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Small in view of Wang, in further view of Kido, which is also previously of record. Claims 9 and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Small in view of Wang, in further view of U.S. Patent No. 7,184,814 to Lang. The Lang reference is new to this office action.

**Preliminary Matters**

Applicant thanks the Examiner for acknowledging receipt of the priority document. Applicant also thanks the Examiner for removing the objection to the drawings. **Applicant respectfully requests the Examiner accept the drawings on the next action.**

**Claim Rejections -- 35 U.S.C. § 103**

*Claims 1, 3-6 and 10-12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Small in view of Wang, both of which are previously of record.*

In the May 24 Amendment, Applicant argued that the Examiner failed to present a *prima facie* case of obviousness because the Examiner did not provide a rationale for modifying the test experiment described in Small to incorporate the diagnostic output information from the feature extraction sub-stage of Wang.

On page 8 of the Final Office Action, the Examiner responds to that argument by citing to the recent Supreme Court decision in *KSR v. Teleflex*. Specifically, the Examiner argues that Small describes that detection of a change in the range of a wrist of at least 6 degrees is significant. The Examiner, citing *KSR*, then argues that based on this design need, it would have been ordinary skill and common sense to combine the diagnostic features of Wang with the test experiment of Small.

Applicant respectfully disagrees. First, merely because a change of 6 degrees is significant does not tell one of ordinary skill how that information may be used for diagnosis. In essence, this portion of Small merely says that it is better to be able to detect movement of the wrist with increased resolution. Second, neither Small nor Wang, nor the Examiner, provide any rationale for how an Euler angle would be used to produce any type of diagnosis. For example, Wang discusses determining a probability of abnormality for various features in the image in order to assist a physician in making a diagnosis. However, there is no indication or logical reasoning provided by the Examiner as to how a Euler angle would be similarly used to produce information to assist with a diagnosis.

Furthermore, the teachings of Small and Wang may not be properly combined. Small relates to analysis by non-invasive opto-electronic tracking based on surface markers attached to the skin of a patient. The reference attempts to eliminate use of the more invasive radiographic techniques.

By contrast, Wang relates to analysis based on radiography, which does not provide useful information based on surface data. Therefore, there is no logical connection between the

Examiner's reliance on Euler angles and the radiological abnormalities in Wang. The Examiner's reliance on *KSR* cannot bridge the gap in the disparate surface analysis of Small and the mammographic radiological abnormalities of Wang.

Assuming, *arguendo*, that Small and Wang may be combined, their combination does not support the rejection. The diagnosis of Wang is based on abnormality detection based on minute density patterns that may appear in the radiological image of breast tissue. By contrast, assuming that the surface marker orientation and displacement of Wang is a characteristic quantity, Wang would not base its diagnosis on such surface-based characteristics. Similarly, abnormalities in Wang do not inherently include any characteristics based on movement.

Accordingly, Applicant submits that claim 1 would not have been rendered obvious by the teachings of Small and Wang. Therefore, claim 1 is patentable over the applied art. Claims 3-6 and 10-12 are patentable at least by virtue of their dependency from claim 1.

Additionally, during an interview performed on September 13, 2007, the Supervisory Patent Examiner (SPE) did indicate that the Small article and the Wang reference would not be combinable, since Small obtains surface data, while Wang makes a diagnosis based on radiographic images. Thus, the SPE indicated that a new Non-Final Office Action would be issued in the instant application based on this argument.

*Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Small in view of Wang, in further view of Kido, which is also previously of record.*

Claims 7 and 8 are dependent from claim 1. Because a proposed combination of Small and Wang fails to render claim 1 obvious, and because Kido fails to cure the deficiency in the

*prima facie* case of obviousness regarding claim 1, claims 7 and 8 are patentable at least by virtue of their dependency.

*Claims 9 and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Small in view of Wang, in further view of U.S. Patent No. 7,184,814 to Lang.*

Claims 9 and 13 are dependent from claim 1. Because a proposed combination of Small and Wang fails to render claim 1 obvious, and because Lang fails to cure the deficiency in the *prima facie* case of obviousness regarding claim 1, claims 9 and 13 are patentable at least by virtue of their dependency.

With further regard to claims 9 and 13, these claims recite the feature wherein at least three images are taken during the movement of the predetermined part. The Examiner acknowledges that Small and Wang do not teach this feature, but cites to Lang at Fig. 1, #32; and col. 14, lines 15-28 as allegedly curing the deficiency. At the cited portion, Lang teaches using at least two cameras to take images of the subject in a static state, and also taking images of the subject while the subject is moving. The Examiner then argues that since images are taken when there is no motion and when the subject is moving, there are at least three images/positions taken.

However, Applicant submits that the Small and Lang references teach away from their combination. At page 481, col. 2, lines 14-15, Small describes using customized fiberglass half-casts to limit the movement of the hands in two postures in order to reduce test-retest differences. Thus, Small teaches immobilizing the hand, and taking only static images of the various

postures. Accordingly, Applicant submits that one having ordinary skill would not have been motivated to combine the teachings of Lang with the teachings of Small for this reason.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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